

REMARKS

Claims 1-2, 4-11, 13-16, 18-20, and 22-31 are pending.

Claims 3, 12, 17, and 21 have been cancelled.

In the Office Action dated August 26, 2009, claims 1, 2, 4, 5, 7-11, 13-15, 24, 25, and 27 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,708,595 (Maloney); claim 6, 26, 28, and 29-30 were rejected under 35 U.S.C. § 103(a) as unpatentable over Maloney in view of U.S. Patent No. 2,894,587 (McCulloch); claims 16, 18-20, 22 and 23 were rejected under 35 U.S.C. § 103(a) as unpatentable over Maloney in view of U.S. Patent No. 5,031,697 (Wellington); claims 1, 2, 4-11, 13-15 and 24-30 were rejected under 35 U.S.C. § 103(a) as unpatentable over McCulloch in view of Maloney; and claims 16, 18-20, 22, 23 and 31 were rejected under 35 U.S.C. § 103(a) as unpatentable over McCulloch in view of Maloney and further in view of Wellington.

The Office Action argued that the term “separate” as used in the claims can be construed broadly such that two objects may be attached and still be separate. 8/26/2009 Office Action at 2. To address this interpretation, the claims have been amended to specify that injection tool is separate from and not in contact with a tubing/tubular string. Support for the amendment can be found at least in Figures 1-6 of the present application, and the accompanying text.

In view of the amendment made to the independent claims, it is respectfully submitted that the § 102 rejection of the claims over Maloney has been rendered moot.

Each independent claim was alternatively rejected as purportedly obvious over McCulloch in view of Maloney.

It is respectfully submitted that this obviousness rejection is defective. Note that claim 1 recites that the gas lift valves are attached to the tubular member **of the gas injection tool that is separate from and not in contact with the tubing string**. In contrast, Maloney specifically teaches that the unloading valves 30 are part of the production string 21. Maloney, 3:28-32. On the other hand, the extension member 40 shown in the various figures of McCulloch does not have gas lift valves, as recited. Therefore, even if Maloney and McCulloch could be hypothetical combined, the hypothetical combination of the references would not have disclosed or hinted at all elements of claim 1.

In addition, since Maloney specifically teaches that its sidestring 28 is in contact with the production string 21, and that the unloading valves 30 are part of the production string 21, a person of ordinary skill in the art would have been led away from providing gas lift valves on a tubular member of a gas injection valve that is separate from and not in contact with the tubing string. Therefore, this person of ordinary skill would have found no reason to combine the reference teachings to achieve the claimed subject matter.

Claim 1 is therefore non-obvious over Maloney and McCulloch. Independent claims 7, 13, 14, and 22 are allowable for similar reasons as claim 1.

Dependent claims are allowable for at least the same reasons as corresponding independent claims. In view of the allowability of base claims, the obviousness rejections of dependent claims have been overcome.

Allowance of all claims is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 20-1504 (SHL.0343US).

Respectfully submitted,

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